

IN THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 2. This sheet, which only includes Fig. 2, replaces the original sheet including Fig. 2.

Attachment: Replacement Sheet (1)

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendments and in light of the following discussion, is respectfully requested.

Claims 1, 4-9, 11-20, 23-28, 30-39, 42-47, and 49-63 are pending. Claims 1, 4-5, 11, 14, 18, 20, 23, 30, 33, 39, 42-43 and 49 are amended. Claims 58-63 are newly added, and Claims 2-3, 10, 21-22, 29, 40-41, and 48 are canceled without prejudice or disclaimer. No new matter is introduced.¹

In the outstanding Office Action, Figures 1-4 were objected to for not containing the legend "Prior Art"; Figure 2 was objected to for containing informalities; Claims 39-57 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; Claim 4 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; Claims 1, 19, 20, 38, 39, and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweitzer et al. (U.S. Patent No. 6,018,617, hereafter "Sweitzer"); Claims 2-7, 10-15, 21-26, 29-34, 40-45, and 48-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweitzer in view of Miele (U.S. Patent No. 7,286,793, hereafter "Miele"); Claims 8, 9, 18, 27, 28, 37, 46, 47, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweitzer and Miele in further view of Ho et al. (U.S. Patent No. 5,779,486, hereafter "Ho"); and Claims 16, 17, 35, 36, 54, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweitzer and Miele in further view of Lippman (U.S. Patent No. 6,544,042, hereafter "Lippman").

Initially, Applicant gratefully acknowledges the courtesy of Examiner Anderson and her supervisor, Examiner Boyce, in holding a personal interview with Applicant and Applicant's representatives on August 12, 2008, during which time the issues of the

¹ Non-limiting support for the amended claims and the new claims can be found at least at paragraphs [0033, 0067, 0068, and 0069], for example. Non-limiting support can also be found in the claims as originally filed.

outstanding Office Action were discussed as summarized hereinafter, and also in the Interview Summary, which the Examiner has made of record. During the interview the rejection of the independent claims as being unpatentable over Sweitzer in view of Miele was discussed. Agreement was reached that amending the independent claims to include the feature “awarding the predetermined total amount of points for a correct answer and awarding a predetermined part of the predetermined total amount of points to one of an alternate answer and an answer that deviates from the correct answer by the predetermined criteria” will overcome the cited references, and otherwise promote efficient prosecution. Applicants have so amended the claims.

In reply to the objection to Figures 1-4, Applicants note that MPEP § 608.02(g) only requires a designation such as “Prior Art.” Thus, the legend “Prior Art” is provided in MPEP § 608.02(g) as an example, not as the only legend to be used when illustrating art that is old. As Figures 1-4 contain the legend “Background Art”, it is submitted that Figures 1-4 comply with the requirements of MPEP § 608.02(g) because this legend is sufficient to establish what is old. Therefore, it is submitted that the objection to Figures 1-4 for not containing the label “Prior Art” is improper, and it is respectfully requested that this objection be withdrawn.

Further, Figure 2 is amended to make the reference character “21” clearer, and to assign the test taker the reference character 23a and the test maker the reference character 23b. The specification is also amended at page 2, paragraph [0007] consistent with the amendments to Figure 2. Accordingly, it is submitted that Figure 2 now complies with the requirements of 37 C.F.R. § 1.84(b)(4), and therefore it is respectfully requested that the objection to Figure 2 under this section be withdrawn.

Amended Claims 1 and 39 is amended to comply with the requirements of 35 U.S.C. § 101, and Claims 42-47 and 49-57 also comply with the requirements of this section for depending from Claim 39 either directly or indirectly. Claims 40-41 and 48 are canceled

without prejudice or disclaimer. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 101 of Claims 39, 42-47, and 49-57 be withdrawn.

Amended Claim 4 is amended to comply with the requirements of 35 U.S.C. § 112, second paragraph. Therefore, it is respectfully requested that the rejection of Claim 4 under 35 U.S.C. § 112, second paragraph, be withdrawn. However, if the Examiner continues to disagree that Claim 4 is in compliance with 35 U.S.C. § 112, second paragraph, the Examiner is invited to contact Applicants' undersigned representative to discuss appropriate language.

With regard to the rejection of Claims 1, 19, 20, 38, 39 and 57 as being unpatentable over Sweitzer, amended Claim 1 has been amended to recite a computer-based method of administering an assessment including the steps of:

...receiving a request for said assessment *from at least one test taker terminal*, said request including a user identification and an assessment identifier;

storing the user identification and the assessment identifier...

deriving, in a processor, a plurality of dynamic questions from an electronic memory for inclusion in said test, each of the plurality of dynamic questions including a stem question and one of a stem question formula, a stem question range, a stem question variable, and a stem question constant, *and each of the plurality of dynamic questions including a predetermined total number of points for awarding to a provided answer and a predetermined criteria used to evaluate the provided answer;*

evaluating, in the processor, the provided answer provided in response to each dynamic question and each static question retrieved from the electronic memory and included in said test, *said evaluating step including awarding the predetermined total amount of points for a correct answer and awarding a predetermined part of said total amount of points for one of an alternate answer and an answer that deviates from the correct answer by the predetermined criteria;*

creating the assessment based on the evaluated answers, said assessment including an assessed level of knowledge;

creating a recommendation based on the assessment, *when the assessed level of knowledge is lower than a predetermined trigger...* (emphasis added).

Turning to the applied references, Sweitzer describes a method and system for generating *printed* examinations or tests containing relatively complex visual elements such as mathematical symbols, operators, expressions, graphs, and equations.² Sweitzer further describes allowing an author to state a problem as a high-level, abstract expression, from which the system generates variations and determines their presentation automatically.³ Sweitzer then describes an authoring tool 30 that allows a user to create problems by keying them from scratch, by duplicating existing problems and modifying the duplicate, or by editing preexisting problems.⁴ Thus, in Sweitzer, the user defines a set of rules for filling in variables that the user places in the question he or she is creating, and the authoring tool 30 and print engine 90 use these rules to replace the variables in the problems with numbers, text, graphics, or mathematical expressions that vary for each copy of the question.⁵

The outstanding Office Action appears to associate the receiving a request for said assessment from at least one test taker terminal, recited in amended Claim 1, with “allowing an author to state a problem as a high-level, abstract expression from which the system generates variations and determines the presentation automatically” of Sweitzer.⁶ However, Sweitzer describes generating test questions based on input from the author, not the test taker. Therefore, Sweitzer does not disclose this feature recited in amended Claim 1.

Further, Sweitzer does not disclose that the evaluation includes awarding a predetermined total amount of points for a correct answer and awarding a predetermined part of said total amount of points for one of an alternate answer and an answer that deviates from the correct answer by a predetermined criteria, as recited in amended Claim 1. This feature is also not disclosed in the other applied references: Miele, Lippman, or Ho. Therefore, no

² Sweitzer at column 1, lines 5-11.

³ Id. at column 3, lines 1-5.

⁴ Id. at column 9, lines 44-47; see also Figure 1.

⁵ Id. at column 11, lines 13-21; also column 12, lines 24-38.

⁶ See the outstanding Office Action at page 5, item 11.

combination of Sweitzer, Miele, Lippman, or Ho describes every element recited in amended Claim 1, and amended Claim 1 is in condition for allowance.

As first recognized by the present inventors, a new synergistic effect is created among the features of evaluating an answer for each dynamic question, creating an assessment based on the evaluated answers, and creating a recommendation based on the assessment as recited in amended Claim 1. These features combine to create a more effective set of recommendations to a test taker, a test maker, a test administrator/teacher, a supervisor or a human resources agent, or a vendor by recommending only those solutions or available methodologies which would be most effective relative to the test subject's assessment.⁷

In rejecting amended Claims 1, 20 and 39 the outstanding Office Action took official notice of a group identifier as recited in these claims.⁸ However, MPEP § 2144.03(a) states:

‘[T]he board cannot simply reach conclusions based on its own understanding or experience --or on its assessment of what would be basic knowledge or common sense. Rather, the board must point to some concrete evidence in the record in support of these findings.’⁹

Therefore, it is requested that the next Office Action contain documentary evidence demonstrating how this assertion by the outstanding Office Action is “capable of instant and unquestioning demonstration as being well-known.”¹⁰

For the reasons discussed above, it is submitted that amended Claim 1 is in condition for allowance. Further, amended Claims 20 and 39 recite substantially the same features as amended Claim 1, and are in condition for allowance for substantially the same reasons. Claims 19, 38, and 57 are in condition for allowance for at least the same reasons as amended Claims 1, 20, 39, on which they respectively depend. Accordingly, it is respectfully

⁷ See, e.g., the specification at paragraphs [0013-0015].

⁸ See the outstanding Office Action at page 7, lines 5-11.

⁹ Quoting *Zirco*, 258 F.3d at 1385, 59 USPQ2d at 1697.

¹⁰ MPEP § 2144.03(a).

requested that the rejection under 35 U.S.C. § 103(a) of amended Claims 1, 19, 20, 38, 39 and 57 be withdrawn.

Regarding the rejection of amended Claims 2-7, 10-15, 21-26, 29-34, 40-45 and 48-53 as being unpatentable over Sweitzer in view of Miele, Claims 2-3, 10, 21-22, 29, 40-41, and 48 have been canceled without prejudice or disclaimer. Amended Claims 4-7, 11-15, 23-26, 30-34, 42-45 and 49-53 respectively depend from Claims 1, 20 and 39. As discussed above, no combination of Sweitzer and Miele describes every feature recited in amended Claims 1, 20 and 39. Therefore, no combination of Sweitzer and Miele describes every feature recited in the Claims 4-7, 11-15, 23-26, 30-34, 42-45 and 49-53, and Claims 4-7, 11-15, 23-26, 30-34, 42-45 and 49-53 are in condition for allowance. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) of Claims 4-7, 11-15, 23-26, 30-34, 42-45 and 49-53 be withdrawn.

In rejecting amended Claims 3, 21 and 41, the outstanding Office Action took official notice of receiving and storing a user identification and an assessment identifier.¹¹ As discussed above, such a taking of official notice is improper without some concrete evidence in the record. Therefore, it is respectfully requested that the next Office Action contain documentary evidence demonstrating how this assertion by the outstanding Office Action is “capable of instant and unquestionable demonstration as being well-known.”¹²

Regarding the rejection of Claims 8, 9, 18, 27, 28, 37, 46, 47, and 56 as being unpatentable over Sweitzer and Miele in further view of Ho, Applicants note that these claims respectively depend from amended Claims 1, 20 and 39. As discussed above, no combination of Sweitzer, Miele and Ho describes every element recited in amended Claims 1, 20 or 39. Therefore, no combination of Sweitzer, Miele and Ho describes every element

¹¹ See the outstanding Office Action at page 8, the last full paragraph on the page.

¹² MPEP § 2144.03(a).

recited in amended Claims 8, 9, 18, 27, 28, 37, 46, 47, and 56. Thus, Claims 8, 9, 18, 27, 28, 37, 46, 47, and 56 are in condition for allowance, and it is respectfully requested that the rejection under 35 U.S.C. § 103(a) of these claims be withdrawn.

With respect to the rejection of Claims 16, 17, 35, 36, 54 and 55 under 35 U.S.C. § 103(a) as being unpatentable over Sweitzer and Miele in further view of Lippman, it is noted that these claims respectively depend from amended Claims 1, 20 and 39, and that no combination of Sweitzer, Miele and Lippman describes every element recited in amended Claims 1, 20, and 39. Accordingly, no combination of Sweitzer, Miele and Lippman describes every element recited in amended Claims 16, 17, 35, 36, 54, and 55, and it is submitted that these claims are in condition for allowance. Therefore, it is respectfully requested that the rejection of amended Claims 16, 17, 35, 36, 54 and 55 under 35 U.S.C. § 103(a) be withdrawn.

New Claims 58-63 recite features not disclosed in the applied art, and further, new Claims 58-63 respectively depend from amended Claims 1, 20, and 39. Therefore, new Claims 58-63 are also in condition for allowance.

For the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance for Claims 1, 4-0, 11-20, 23-28, 30-39, 42-47, and 49-63 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encourage to contact Applicants' undersigned representative at the below-listed telephone number.

Respectfully submitted,

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